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EXAMINER
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SNAPP, SANDRA S

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 12/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/733,409

Applicant(s)

HUI ET AL.

Examiner

Sandra Snapp

Art Unit

3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 08 November 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☒ Claim(s) 14 and 16 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 December 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Specification*

The disclosure is objected to because of the following informalities: on page 5, line 11, the phrase "Referring to figs. 1 to 4" is incorrect since there are only 3 figures in the application. Appropriate correction is required.

### *Claim Objections*

Claim 2 is objected to because the term "product" should be in the plural form "products."

Claim 14 is objected to because the preamble is in a form that is unacceptable. The Applicant is directed to section 609 of the M.P.E.P. for the proper format for dependent claims.

Claim 14 is also objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Since the Applicant is claiming that the information in claim 14 is in claim 2, and claims 4 and 9 depend from claim 2, then the information further added to claims 4 and 9 is redundant as it is already part of the subject matter due to its inclusion in claim 2. This same issue applies to the information of claims 3 & 8 as well.

Claim 16 is objected to because the phrase "password and confirmation are authenticate" is awkward. The Examiner suggests the phrase "password and confirmation are authentic."

*Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 14 and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 14 is indefinite because the phrase “said communication device” lacks proper antecedent basis. There appear to be earlier references to a communication terminal, is that what the Applicant intends by using the term “device?” If so, consistent language should be used throughout the entire application. If the communication device and terminal are meant to refer to two separate limitations, then “said” should not precede communication device.

Claim 16 is indefinite because lines 27-28 are confusing and redundant. Lines 25 & 16 on page 16 state, “a mobile server, which communicates with said network server via an Internet” and then lines 27-28 further states “said network server communicates with said mobile server via an Internet.”

Claim 22 is indefinite because it is unclear whether the second reference to “an operation center”, in line 9 on page 18, is the same operation center as recited previously in lines 6-7 or a different one. If they are the same centers, then the second and subsequent occurrences should be preceded by “the” or “said.”

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-9, 14, 15, 22, 23, 26 and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by the Jalili patent (US 6,088,683).

The Jalili patent discloses a mobile payment system, comprising the steps of:

Receiving a payment request in an operation center from a registered merchant through a communication network (col. 2, lines 28-39), requesting the registered merchant to inform a customer ID of a customer, who is a registered member of the operation center, and a transaction amount to be paid by the customer to the registered merchant (col. 1, lines 60-67), verifying a merchant ID of the registered merchant by the operation center (col. 2, lines 28-39), confirming the payment request by the operation center by the notifying customer and requesting for verification (col. 2, lines 40-67), requesting the customer to verify the payment transaction by confirming the transaction amount and inputting a security password of the customer registered in the operation center (col. 2, lines 40-48), and confirming with the registered merchant whether the payment request is issued (col. 3, lines 1-6) (claim 1);

Indicating to the registered merchant that the customer prefers to settle a payment through a mobile payment system when the customer decides to purchase one or more products from the registered merchant (col. 2, lines 8-14), initialing transaction by sending the payment

Art Unit: 3624

request to the operation center by the registered merchant through a communication terminal (col. 2, lines 28-39) (claim 2);

Requesting the customer ID and the transaction amount by the operation center (col. 2, lines 40-67), entering the customer ID and the transaction amount to be paid to the registered merchant through the communication terminal (col. 2, lines 40-67) (claims 3 & 4);

Further transaction information is requested by the operation center, wherein the transaction information includes but is not limited to product code, transaction date and time, and identification of the registered merchant (col. 2, lines 28-39) (claim 5);

Receiving the customer ID and the transaction amount from the registered merchant by the operation center (col. 2, lines 28-39), and verifying identity of the registered merchant by checking a merchant database by the operation center (col. 2, lines 28-39) (claims 6, 7, 8, 9);

Sending a notification message to the communication device of the customer to indicate the payment request (col. 2, lines 49-67), verifying the transaction amount and other transaction information with the customer (col. 2, lines 49-67) (claim 14); and

Requesting the customer to confirm the transaction amount and to enter the security password of the customer (col. 2, lines 40-48), and verifying the transaction amount and inputting the security password by the customer (col. 2, lines 40-48) (claim 15).

The Jalili patent also discloses a mobile payment system, comprising:

At least a communication terminal installed by a merchant registered in an operation center as registered merchant (col. 2, lines 40-67), a communication network for connecting the communication terminal of the registered merchant with the operation center, the registered

Art Unit: 3624

merchant is capable of submitting a payment request to the operation center, wherein after the operation center receives the payment request, the operation center is capable of requesting the registered merchant inform a customer ID of a customer, who is a registered member of the operation center, and a transaction amount to be paid by the customer to the registered merchant (col. 2, lines 40-67), and a communication device, which is carried by the customer, connecting with the operation center for receiving confirmation message from the operation center to verify a payment amount requested by the registered merchant for at least a product purchased by the customer from the registered merchant, by entering a security password of the customer in the communication device for transmitting to the operation center (col. 2, lines 40-67) (claim 22);

The operation center comprises a network server for receiving the payment request from the registered merchant and a mobile server, which communicates with the network server via an Internet, for confirmation of the payment with the customer (col. 2, lines 40-67) (claim 23);

The communication terminal is connected with the operation center through a dial-up telephone line (col. 2, lines 40-67) (claim 26); and

The communication terminal is connected with the network server through a dial-up telephone line (col. 2, lines 40-67) (claim 27).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 10-13, 16-21, 24, 25, 28 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Jalili patent in view of the Nessett et al. patent (US 6,055,236).

The Jalili patent discloses all the elements of the present invention, except:

The communication device is a WAP phone and further includes pushing a transaction request to the WAP phone of the customer using WAP 1.2 push architecture when the identity of the registered merchant and the transaction amount are valid (claims 10, 11, 12, 13);

The operation center comprises a network server for receiving the payment request from the registered merchant, and a mobile server, which communicates with the network server via an Internet, for confirmation of the payment with the customer and in which the network server communicates with the mobile server, and further comprising requesting the customer to confirm the transaction amount and to enter the security password of the customer, verifying the transaction amount and inputting the security password by the customer, transmitting the security password and confirmation to the network server via an Internet using IPSec protocol, scrutinizing the security password and confirmation by a firewall of the network server to make sure the security password and confirmation are authenticate, and verifying the security password of the customer by the network server of the operation center by checking the customer database thereof (claim 16);

Issuing a final transaction receipt by the communication terminal to complete the payment transaction and printing a transaction receipt by the communication terminal to complete the payment transaction (claim 17);



Art Unit: 3624

The security password is a phone number of the WAP phone of the customer (claims 18 & 19);

The communication network is a WAP secured transaction layer cellular network (claims 20 & 21);

The communication device is a WAP phone communicating with the operation center via a cellular network (claims 24 & 25);

The communication terminal is connected with the operation center through a dial-up telephone line (claim 28); and

The communication terminal is connected with the network server through a dial-up telephone line (claim 29).

The Nessett patent teaches:

The communication device is a WAP phone and further includes pushing a transaction request to the WAP phone of the customer using WAP 1.2 push architecture when the identity of the registered merchant and the transaction amount are valid (Nessett, Abstract) (claims 10, 11, 12, 13);

The operation center comprises a network server for receiving the payment request from the registered merchant, and a mobile server, which communicates with the network server via an Internet, for confirmation of the payment with the customer and in which the network server communicates with the mobile server, and further comprising requesting the customer to confirm the transaction amount and to enter the security password of the customer (Jalili, col. 2, lines 40-67), verifying the transaction amount and inputting the security password by the customer (Jalili,

Art Unit: 3624

col. 2, lines 40-67), transmitting the security password and confirmation to the network server via an Internet using IPSec protocol (Nessett, Abstract), scrutinizing the security password and confirmation by a firewall of the network server to make sure the security password and confirmation are authentic (Jalili, col. 3, lines 7-15), and verifying the security password of the customer by the network server of the operation center by checking the customer database thereof (Jalili, col. 2, lines 40-67) (claim 16);

Issuing a final transaction receipt by the communication terminal to complete the payment transaction (Jalili, col. 3, lines 1-6) and printing a transaction receipt by the communication terminal to complete the payment transaction (Examiner takes Official Notice that since the Jalili system identifies sending a confirmation via e-mail, it is well known in the art that e-mail messages can be printed, as such, it would have been obvious to one of ordinary skill in the art to print a receipt from the e-mail notice) (claim 17);

The security password is a phone number of the WAP phone of the customer (Jalili, col. 2, lines 40-48, and Nessett, Abstract) (claims 18 & 19); and

The communication network is a WAP secured transaction layer cellular network (Jalili, col. 2, lines 40-48, and Nessett, Abstract) (claims 20 & 21);

The communication device is a WAP phone communicating with the operation center via a cellular network (Jalili, col. 2, lines 40-67 and Nessett, Abstract) (claims 24 & 25);

The communication terminal is connected with the operation center through a dial-up telephone line (Jalili, col. 2, lines 40-57) (claim 28); and

The communication terminal is connected with the network server through a dial-up telephone line (Jalili, col. 2, lines 40-67) (claim 29).

Art Unit: 3624

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the Jalili system with the teachings of the Nessett system so as to provide a more convenient, wider reaching network (including cellular in addition to convention LAN line telephone systems) while still maintaining a secure system.

### *Conclusion*

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The Lamm, Dent et al., Demers et al., Hilt et al., Talati et al., Chen et al., Gorog, Sharpe et al., Kight et al., Haller et al., Rowney et al., Kravitz, Gifford, Shavit et al., Rose et al. and Remington et al. patents are for various types of electronic payment systems. The Adelman et al., Hardjono and Hansen (European) patents are directed to systems that use IPSec protocol. The Teicher, Pollin, Bahreman, and Nikander patents are for electronic systems using cellular technology. The Randle and Hogan systems are for electronic commerce systems with identification capabilities. The Chen et al., Alfano et al., Ho-A-Chuck, Jackson, Jr. and Wang (European) patents are for systems having mobile servers.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sandra Snapp whose telephone number is 703-305-6940. The examiner can normally be reached on Mon.-Thurs..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 703-308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-305-7687.

Art Unit: 3624

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

  
SS



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